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SUTHERLAND II SUTHERLAND, ASBILL & BRENNAN, LLC 999 PEACHTREE STREET ATLANTA, GA 30309			EXAMINER COLBERT, ELLA	
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			3696	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/820,803

Applicant(s)

GANESAN ET AL.

Examiner

Ella Colbert

Art Unit

3696

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 12-15, 24, 25, 35-38, 56, 59-66 and 69-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 12-15, 24, 25, 35-38, 56, 59-66 and 69-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Page No(s)/Mail Date 02/12/09

DETAILED ACTION

1. Claims 1, 2, 12-15, 24, 25, 35-38, 56, 49-66, and 69-76 are pending. Claims 1, 12, 14, 15, 24, 35, 37, 38, 56, 59-66, and 69-76 have been amended in this communication filed 02/11/09 entered as Amendment with filing of RCE.
2. The IDS filed 02/12/09 has been entered and considered.
3. The newly submitted replacement drawings filed 02/20/09 fails to overcome the drawing objections as set forth here below.
4. The objections to the Specification have been overcome by Applicants' amendment and are hereby withdrawn.
5. The 35 USC 112 First Paragraph rejection has been overcome in part by Applicants' amendments to the claims and is withdrawn in part as set forth here below.
6. The 35 USC 112, second paragraph rejections for claims 1, 24, 56, 61, 66, 71, and 76 still remain as set forth here below. The 35 USC 112, second paragraph rejections for claims 60, 70, and 74 are hereby withdrawn in view of Applicants' amendment to the claims.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/11/09 has been entered.

Drawings

The drawings are objected to because Figures 1, 3, 5, 9, 11, and 13 have the words "REPLACEMENT SHEET" inside of the drawing figure margins. For printing purposes, the words "REPLACEMENT SHEET" need to be outside of any drawing figure margins and preferably at the very top of the drawing page.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 56, 59, 60, and 62-65 are objected to because of the following informalities: claim 56 recites “means for receiving, at processing agent processor ...,” This should be recited as “means for receiving, at a processing agent processor ...,”

Claim 59 recites “..., wherein executing computer-implemented instructions performed by one or more processing agent processors further comprises executing computer implemented instructions by one or more processing agent processors for:”. This recitation is redundant. The claim recitation would be better recited as “..., wherein further executing computer-implemented instructions performed by one or more processing agent processors for:”. Claims 60 and 62-65 have a similar problem.

Appropriate correction is required.

Claims 2, 12-14, 25, and 35-37 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Rule 1.75 (c) provides that “[0]ne or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. See also MPEP 608.01 (n), under the heading “III Infringement Test”, second paragraph, wherein it states, “[t]he test for a proper dependent claim under the fourth paragraph of 35 USC 112 is whether the dependent claim includes every limitation of the claim from which it depends”. See MPEP 608.01 (n).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 12, 15, 24, 56, 61, 62, and 71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim1 recites “first set of payees”, “second set of payees”, and “processing agent processors” is not found in Applicants' specification. “Processing agent 130” is found throughout Applicants' Specification. Claims 12, 15, 24, 38, 56-62, 64-72, and 74-76 have a similar problem with the recitations in the claims containing a lack of support not found in the specification and the drawings. Claims 2, 12-15, 25, 35-38, and 57-76 are also rejected because of their dependency fro a rejected claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 24, 56, 61, 66, 71, and 76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 as amended in the third claim limitation reciting “setting, at the processing agent a registration ..., wherein

..., and wherein ... a second set of payees, wherein the ...;". The metes and bounds of this claim limitation cannot be determined making the claim limitation indefinite. Claim 1 also recites "processing agent processors" and "the processing agent". It is unclear from reading the specification and viewing the drawings whether the "processing agent" is a person or a device or a piece of software.

Claims 24, 56, 61, 66, 71, and 76 have a similar problem. Claims 2, 12-15, 25, 35-38, and 57-76 are also rejected for their dependency from a rejected claim.

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 12-15, 24, 35-38, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,289,322) Kitchen et al, hereafter Kitchen in view of (US 7,194,437) Britto et al, hereafter Britto in view of (US 6,311,170) Embrey.

Claims 1, 24, and 56. Kitchen discloses, A method comprising: executing computer implemented instructions performed by one or more processing agent processors for (col. 6, lines 29-58): receiving by a processing agent information, via a network,

identifying a network user (col. 6, line 59-col. 7, line 5 and col. 11, lines 41-56); determining by the processing agent responsive to receiving the information identifying the network user, a credit risk associated with making, payments on behalf of the network user (col. 12, lines 35-47). Kitchen failed to disclose, setting at the processing agent, a registration status associated with the network user to one of an open status or a closed status based at least in part on the determined credit risk, wherein the open status indicates the processing agent will process a payment request on behalf of the network user to at least one of first set of payees and wherein, the closed status indicates the processing agent will process a payment request on behalf of the network user to only a second set of payees, wherein the second set of payees is a subset of the first set of payees. Embrey discloses, setting at the processing agent, a registration status associated with the network user to one of an open status or a closed status based at least in part on the determined credit risk, wherein the open status indicates the processing agent will process a payment request on behalf of the network user to at least one of first set of payees and wherein, the closed status indicates the processing agent will process a payment request on behalf of the network user to only a second set of payees, wherein the second set of payees is a subset of the first set of payee (col. 8, lines 6- col. 9, line 40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kitchen with the teachings of Embrey because such a modification would allow Kitchen to reduce the operating and administrative costs for accounting and disbursement activities. Kitchen further discloses, transmitting, from the processing agent, a payment screen,

wherein the payment screen only allows payment to one of the payees of the second set of payees when the registration status associated with the network user is set to a closed state (col. 12, line 55-col. 14, line 44).

The following examples of language in a claim that may raise a question as to the limiting effect of the language in a claim are: (A) statements of intended use or field of use, (B) "adapted to" or "adapted for" clauses, (C) "wherein" clauses, or (D) "whereby" clauses. The list of examples is not intended to be exhaustive." MPEP 2106 II C.

Claim 24, Kitchen further discloses, a communications port configured to receive and transmit information via a network (col. 6, lines 20-28); a memory (col. 6, lines 29-58); and a processor in communication with the communications port and the memory (col. 7, lines 37-51). This independent claim is rejected for the similar rationale as given above for claim 1.

Claims 2 and 25. Kitchen discloses, wherein the information identifying the network user is received from a sponsor of the network user (col. 12, lines 49-65).

Claims 12 and 35. Kitchen failed to disclose, wherein the first plurality of payees is determined by a first entity other than the network user. Britto discloses, wherein the first plurality of payees is determined by a first entity other than the network user (col. 6, lines 13-67).

Claims 13 and 36. Kitchen failed to disclose, wherein the first entity is a sponsor of the network user. Britto discloses, wherein the first entity is a sponsor of the network user (col. 6, lines 3-12).

Claims 14 and 37. Kitchen failed to disclose, wherein the entity is processing agent.

Britto discloses, wherein the entity is processing agent (col. 5, lines 55-65).

Claims 15 and 38. Kitchen discloses, wherein setting the registration status associated with the network user to one of the open status or the closed status is based at least in part upon the identity of the a sponsor of the network user (col. 13, lines 48-62).

Claims 59-66, 69-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,289,322) Kitchen et al, hereafter Kitchen in view of (US 7,194,437) Britto et al, hereafter Britto and further in view of (US 6,311,170) Embrey.

Claims 59, 62, 69, and 72. Kitchen and Britto failed to disclose, wherein executing computer-implemented instructions performed by one or more processing agent processors further comprises executing computer-implemented instructions performed by one or more processing agent processors for: setting the registration status to the closed status prior to determining the credit risk and during a real-time communication session with the network user, wherein the registration status is set to the open status outside a real-time communication session with the network user. Embrey discloses, wherein executing computer-implemented instructions performed by one or more processing agent processors further comprises executing computer-implemented instructions performed by one or more processing agent processors for: setting the registration status to the closed status prior to determining the credit risk and during a real-time communication session with the network user, wherein the registration status

is set to the open status outside a real-time communication session with the network user (col. 15, lines 4-17 and col. 15, line 18-col. 16, line 42). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kitchen with the teachings of Embrey because such a modification would allow Kitchen to have the security of a payment system by minimizing the opportunity for alteration of any negotiable instruments.

Claims 60 and 70. Kitchen, Britto and Embrey failed to disclose, wherein determining the credit risk comprises determining a first credit risk, and wherein executing computer-implemented instructions performed by one or more processing agent processors further comprises executing computer-implemented instructions performed by one or more processing agent processors for: determining, subsequent to setting the registration status, a second credit risk associated with making payments on behalf of the network user; and changing the registration status to the other of the open status and the closed status based at least in part on the determined second credit risk. It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine a credit risk that includes a first credit risk and determine subsequent to setting the registration status to a second credit risk associated with making payments on behalf of the network user; and changing the open status to the closed status based at least in part on the determined second credit risk because this would result in the increase in security of the payment system by minimizing the opportunity for alteration of the negotiable instruments and according to the credit risk being low the status should be set to the first payment status and if the credit risk is high

the payment status should be set to the second payment status in order to reduce the credit risk of the payee.

Claims 61 and 71. Kitchen failed to disclose, wherein a payee is included in the second set of payees as a result of (i) an agreement between the payee and a processing agent transmitting the payment screen, (ii) an agreement between a sponsor associated with the network user and a processing agent transmitting the payment screen, or (ii) an analysis of a history of payments directed to the payee. Britto discloses, wherein a payee is included in the second set of payees as a result of (i) an agreement between the payee and a processing agent transmitting the payment screen, (ii) an agreement between a sponsor associated with the network user and a processing agent transmitting the payment screen, or (ii) an analysis of a history of payments directed to the payee (col. 6, lines 13-33).

Claims 62 and 72. Kitchen and Britto failed to disclose, wherein executing computer-implemented instructions performed by one or more processing agent processors further comprises executing computer-implemented instructions performed by one or more processing agent processors for: changing the registration status from the closed status to the open status. Embrey discloses, further comprising: changing the registration status from the closed status to the open status (col. 15, lines 4-17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kitchen with the teachings of Embrey because such a modification would allow Kitchen to change the payment status according to the increased risk of the user and to achieve efficient operation and streamline the costs for accounting and

disbursement activities.

Claims 63 and 73. Kitchen failed to disclose, wherein executing computer-implemented instructions performed by one or more processing agent processors further comprises executing computer-implemented instructions performed by one or more processing agent processors for: notifying the network user of the change in registration status. Britto discloses, notifying the network user of the change in registration status (col. 7, line 39-col. 8, line 25).

Claims 64 and 74. Kitchen, Britto and Embrey failed to disclose, wherein executing computer-implemented instructions performed by one or more processing agent processors further comprises executing computer-implemented instructions performed by one or more processing agent processors for: receiving a request from the network user to upgrade from the closed status to the open status, wherein the registration status is changed from the closed status to the open status responsive to the received request. It would have been obvious to one having ordinary skill in the art at the time the invention was made to receive a request from the network user to upgrade from the closed status to the open status, wherein the payer status is changed from the closed status to the open status responsive to the received request because this would allow for a more cost efficient and economical operating procedure.

Claims 65 and 75. Kitchen failed to disclose, wherein executing computer-implemented instructions performed by one or more processing agent processors further comprises executing computer-implemented instructions performed by one or more processing agent processors for: storing payment history associated with the network user, wherein

the registration status is changed from the closed status to the open status based on the stored payment history. Britto discloses, wherein executing computer-implemented instructions performed by one or more processing agent processors further comprises executing computer-implemented instructions performed by one or more processing agent processors for: storing payment history associated with the network user, wherein the registration status is changed from the closed status to the open status based on the stored payment history (col. 6, lines 13-33).

Claims 66 and 76. Kitchen, Britto and Embrey failed to disclose, wherein changing the registration status from the closed status to the open status based on the stored payment history includes at least one of (i) determining a length of time the network user has been registered for payment processing, (ii) determining a number of payments directed by the network user, (iii) determining a number of payments directed by the network user for which a debit was not honored, or (iv) determining a function relating a number of payments directed by the network user for which a debit was not honored to a total number of payments directed by the network user. It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine a length of time the network user has been registered for payment processing, (ii) determine a number of payments directed by the network user, (iii) determine a number of payments directed by the network user for which a debit was not honored, or (iv) determine a function relating a number of payments directed by the network user for which a debit was not honored to a total number of payments directed by the network user because these steps would allow service provider to make

payments on behalf to the payor to the payee in a manner which greatly reduces the operating and administrative costs for accounting and disbursement activities.

Applicant(s) are reminded that as a matter of linguistic precision, optional or conditional elements (e.g. "or," "if", "may," etc.) do not narrow the claims because they can always be omitted. See also MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the Applicant(s), in preparing the response, to consider fully the entire references as potentially teaching all of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the Examiner.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hogan (US 5,699,528) disclosed a bill delivery and payment system.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

April 27, 2009